

REMARKS/ARGUMENTS

This is a Response to the Office Action mailed July 12, 2005, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire October 12, 2005. Claims 7, 9, 12, 16, 19, and 48 have been amended. No claims have been canceled. No new claims have been added and no new matter has been added to the application. No fee for additional claims is due by way of this Amendment. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Claims 1-7, 9-37, 41-49, and 57 are pending.

Allowable Subject Matter

Applicants thank Examiner Nguyen for indicating that claim 27 would be allowable if a terminal disclaimer was filed to overcome the double patenting rejection. As discussed below, Applicants believe that the double patenting rejection should be withdrawn. In that regard, Applicants assert that claim 27 is allowable, without a terminal disclaimer.

Rejections Under 37 C.F.R. 1.75

The Examiner has noted that if claim 47 should be found allowable, claim 48 would be objected to as being a substantial duplicate thereof. Applicants have amended claim 48 to be distinct from claim 47.

Nonstatutory Double Patenting Rejection Under 37 CFR 1.130(b)

Claims 1-7, 9-37, 41-49, and 57 of the present application were rejected as not being patentably distinct over claims 1-2, 5, 7, 9-11, 13-15, 17-19, 35, and 39-40 of Applicants' issued patent, U.S. Patent No. 6,638,161 (hereinafter referred to as the '161 patent). The Examiner contends that the rejected claims are broader in scope because the features of "reading an identifier from each of a number of playing cards" (*re*: claim 1 of the '161 patent) and "determining an expected set of playing card values" (*re*: claim 1 of the '161 patent) were eliminated from the rejected claims. In addition, the Examiner states that the feature of "computationally generating a first pseudo-random playing card sequence from a first set of

playing card values, wherein the pseudo-random playing card sequence is generated before a first card in the sequence is printed” would have been an obvious design choice and/or obvious to one of skill in the art. Applicants respectfully traverse these rejections.

When imposing a nonstatutory double patenting rejection, the Examiner must determine if any claim in the application is merely an obvious variation of an invention claimed in another of Applicants’ issued patents or applications. MPEP § 804. Obviousness-type double patenting is proper only when the claimed subject matter in the pending application is not *patentably distinct* from subject matter claimed in a commonly owned patent when the issuance of a application would provide an unjustified extension of patent term. MPEP § 804; and *see Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. MPEP § 804. Any obviousness-type double patenting rejection should clearly identify (1) the differences between the inventions defined by the conflicting claims (*e.g.*, a claim in the patent compared to a claim in the application); and (2) the reasons why a person of ordinary skill in the art would conclude that the claims in the pending application are an obvious variation (*i.e.*, not patentably distinct) of the claims in the issued patent. *Id.*

Claims 1-7, 9-37, 41-49, and 57 of the present application are patentably distinct over the claims in the ‘161 patent. By way of example, claim 1 of the present application is directed to “[a] method of distributing playing cards.” In contrast, claim 1 of the ‘161 patent is directed to [a] method of verifying playing card games.” The process of verifying is fundamentally different and patentably distinct from the process of distributing playing cards. In fact, the processes may be used together to distribute and verify the playing cards. Conversely, one process may be performed without performing the other process. For example, playing cards that are verified in accordance with the ‘161 patent do not have to be distributed in accordance with the presently claimed invention. Thus, the verification processes of the ‘161 patent can be performed without necessarily performing the distribution processes of the present application.

Claim 1 of the present application recites two (2) acts for distributing playing cards. In contrast, claim 1 of the '161 patent recites four (4) acts for verifying playing card games. Although this contrast, on its face, may lead to a conclusion that the claims in the present application are "broader," such a conclusion is premature because the features recited in the respective claims are substantially different and thus patentably distinct.

For example, claim 1 of the '161 patent recites, *inter alia*, "determining whether the identifiers read from each of the number of playing cards forming the hand of playing cards correspond to the expected set of playing card values for the playing card hand;" whereas claim 1 of the present application has no such limitation. The converse is also true in that claim 1 of the present application recites, *inter alia*, "printing a plurality of the playing cards having markings corresponding to respective ones of the playing card values in an order matching at least a portion of the generated first pseudo-random playing card sequence;" whereas claim 1 of the '161 patent has no such limitation. Thus, it is possible to infringe the claims of the '161 patent without infringing the claims of the present application. Likewise, it is possible to infringe the claims of the present application without infringing the claims of the '161 patent.

Accordingly, there are substantial, nonobvious differences between the conflicting claims of the present application compared to the claims of the '161 patent. The respective claims are thereby patentably distinct and no terminal disclaimer is necessary. Applicants respectfully request that the Examiner withdraw the nonstatutory, obviousness-type double patenting rejection.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 7, 9, 12, 16, and 19 were rejected under 35 U.S.C. § 112, first paragraph, because the claimed limitation "entire pseudo-random playing card sequence" is not disclosed in the specification. Applicants have amended claims 7, 9, 12, 16, and 19 to remove the term "entire" from the respective claims. Based on the amended claims, Applicants respectfully request that the Section 112 rejection be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-7, 9-26, 28-37, 41-49, and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,199,710 to Lamle. The Examiner acknowledges that Lamle does not explicitly disclose generating a playing card sequence before printing the first card in the sequence, and printing the playing cards in an order matching. Therefore, the Examiner bases the present Section 103 rejection on the contention that Lamle “obviously implies teaching generating a sequence of card signals before printing a first card in the sequence.”

Lamle Does Not Teach Generating A Sequence

Applicants respectfully disagree with the Examiner’s conclusion that Lamle teaches generating a sequence before printing a first card in the sequence. In a response to a Final Office Action entitled Amendment After Final¹ and dated December 29, 2004, Applicants summarized, in detail, Lamle’s step-by-step method of generating a random number and then printing a card. Applicants noted that Lamle repeatedly teaches generating one random number and then printing one card with a card value corresponding to the one random number. See Amendment After Final dated December 29, 2004. In particular, these teachings are found in Lamle, as follows:

1. Feeding the signals to a card stock printer at the playing area and immediately delivering single, leading printed playing cards successively, one-by-one into play. See Abstract.
2. Randomly generated indicia denoting card values are printed on successive leading individual portions of card stock only at the time of delivery of the card to the table. See Column 1, lines 56-59.
3. Operating the printing means to print stock forming successive leading cards with a respective indicia corresponding with the signals received and

¹ The Amendment After Final was placed in the record in accordance with a Request for Continued Examination filed on April 22, 2005.

delivering the printed leading cards successively to the playing area. *See* Column 2, lines 5-9.

4. To feed only a leading piece of card stock to the printer. The printer prints an indicia on the face of the card stock corresponding to the signal received from the CPU and the card is immediately delivered through the delivery slot by the delivery belt onto the table surface. *See* Column 3, lines 32-39.

Based on the foregoing, repeated and express teachings in Lamle, Applicants submit that Lamle does not imply, suggest, or provide any motivation for teaching that a “pseudo-random playing card sequence is generated before a first card in the sequence is printed” (e.g., claim 1). Consequently, Applicants respectfully request that the Examiner withdraw the Section 103 rejection in view of Lamle.

The Examiner Has Not Made a Prima Facie Case of Obviousness

The Examiner has not made out a *prima facie* case of obviousness. While a *prima facie* case of obviousness can be established by modifying the teachings of the prior art to produce the claimed invention, but there *must* be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the reference or in the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01 (emphasis added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Lamle does not meet the test for an implicit showing. First, Lamle explicitly and repeatedly teaches, in various ways, that “[t]he printer prints an indicia on the face of the card stock corresponding to the signal received from the CPU and the card is immediately delivered through the deliver slot by the delivery belt on the [table] suface” (Column 3, lines 32-39). Accordingly, Lamle teaches generating one signal, then printing one card, and then repeating the process. Second, the nature of the problem solved in Lamle is to minimize or eliminate card counting by employing a relatively slow randomization and printing process. In contrast, Applicants have attempted to solve the problem of increasing the speed of the game play. (Page

19, lines 26-28). Accordingly, the Examiner has not met the test that Lamle supplies any implicit teaching, suggestion, or motivation to one of ordinary skill in the art. Because a *prima facie* case of obviousness has not been established, Applicants respectfully request that the Examiner withdraw the Section 103 rejections.

The Examiner's Conclusion Is Not Properly Supported in the Record

The Examiner's unsupported conclusion that Lamle "obviously implies teaching generating a sequence of card signals before printing a first card in the sequence" is not supported by documentary evidence in the record. General conclusions concerning what may be basic, common, or even implicit knowledge to one of ordinary skill in the art must be supported by specific factual findings and at least some concrete evidence in the record. *See In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002); and *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). As the court held in *Zurko*, conclusions based on basic knowledge and/or common sense that are not supported by any evidence in the record lack substantial evidentiary support and cannot support an obviousness rejection. *Zurko*, 277 F.3d at 1385.

In addition, one cannot selectively choose portions of a reference, but rather must consider the reference as a whole, including those portions of the reference that teach away from the claimed subject matter. *See* MPEP § 2141.02 *citing* *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Examiner has yet to provide any rationale or evidence for why one of ordinary skill in the art would be motivated to ignore the *clear and repeated* teachings of Lamle. Nor has the Examiner identified any other contemporaneous reference that would provide a motivation to ignore the *clear and repeated* teachings of Lamle. Such references may be unavailable because there was a commonly held belief in the industry at the time of Applicants' filing, and before, that a prior knowledge of the order of cards coming out of a card shoe, for example, would be unacceptable to casino patrons and/or gaming commissions. In fact, Applicants lead the way in challenging what was the conventional wisdom of those of ordinary skill in the art at the time. Because there

is no evidence in the record to support the conclusion regarding Lamle's alleged, implied teaching, Applicants respectfully request that the Examiner withdraw the Section 103 rejections.

Conclusion

Overall, the cited references do not singly, or in any motivated combination, teach or suggest the claimed features of the embodiments recited in the independent claims, and thus such claims are allowable. Because the remaining claims depend from the allowable independent claims, and also because they include additional limitations, such claims are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In light of the above amendments and remarks, Applicants respectfully submit that all pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. Examiner is encouraged to contact Mr. Vershave by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Vershave by telephone to expediently correct such informalities.

Respectfully submitted,
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